

**DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION
USING AN APPLICATION DATA SHEET (37 CFR 1.76)**

As the below named inventor(s), I/we declare that:

This declaration is directed to:

- ☐ The attached application, or
- ☒ Application No. 09/866,132, filed on May 25, 2001,
- ☐ as amended on _____ (if applicable);

I/we believe that I/we am/are the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought;

I/ we have reviewed and understand the contents of the above-identified application, including the claims, as amended by any amendment specifically referred to above;

I/we acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me/us to be material to patentability as defined in 37 CFR 1.56, including material information which became available between the filing date of the prior application and the National or PCT International filing date of the continuation-in-part application, if applicable; and

All statements made herein of my/own knowledge are true, all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issuing thereon.

FULL NAME OF INVENTOR(S)

Inventor one Jennifer L. Harris Date: 23 Aug 01

Signature: [Signature] Citizen of: U.S.

Inventor two Bradley J. Backes Date: _____

Signature: [Signature] Citizen of: U.S. 23 Aug 01

Inventor three Jonathan A. Ellman Date: 27 Aug 01

Signature: [Signature] Citizen of: U.S.

Inventor four Charles S. Craik Date: 27, August, 2001

Signature: [Signature] Citizen of: U.S.

☐ Additional inventors are being named on _____ additional form(s) attached hereto.



STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: Jennifer L. Harris, et al.

Application No./Patent No.: 09/866,132

Filed/Issue Date: May 25, 2001

Entitled: Profiling Of Protease Specificity Using Combinatorial Fluorogenic Substrate Libraries

The Regents of the University of California, a California corporation

(Name of Assignee)

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or
2. ☐ an assignee of an undivided part interest

in the patent application/patent identified above by virtue of either:

- A. ☒ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

OR

- B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

2. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

3. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

- ☐ Copies of assignments or other documents in the chain of title are attached.

[NOTE: A separate copy (i.e., the original assignment document or a true copy of the original document) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.8]

The undersigned (whose title is supplied below) is empowered to sign this statement on behalf of the assignee.

August 13, 2001
Date

Susan Y. Nakashima
Signature

Ms. Susan Y. Nakashima

Typed or printed name

Business Manager

Title

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

Attorney Docket No.: 18062G-003210US
UC Reference No.: SF99-113-2

JOINT

ASSIGNMENT OF PATENT APPLICATION

U.C. Case No. SF99-113-2

For good and valuable consideration, the receipt of which is hereby acknowledged, ASSIGNOR(S),

- | | |
|------------------------------|-----------------------------|
| 1. <u>Jennifer L. Harris</u> | 2. <u>Bradley J. Backes</u> |
| 3. <u>Jonathan A. Ellman</u> | 4. <u>Charles S. Craik</u> |

hereby sells, assigns and transfers to ASSIGNEE, University of California, San Francisco a California Corporation, having its administrative offices located at 1294 9th Avenue, Suite 1, P.O. Box 1209, San Francisco, California 94143-1209, and the successors, assigns and legal representatives of the ASSIGNEE all of its right, title and interest for the United States and its territorial possessions and in all foreign countries in and to, any and all improvements which are disclosed in the invention entitled:

**PROFILING OF PROTEASE SPECIFICITY USING COMBINATORIAL FLUOROGENIC
SUBSTRATE LIBRARIES**

and which is found in

- (a) _____ U.S. provisional application filed herewith and listing the above-named persons as inventors
- (b) _____ U.S. patent application filed herewith and listing the above-named persons as inventors
- (c) X U.S. application serial no. 09/866,132, filed on May 25, 2001
- (d) _____ U.S. Patent No. _____, issued _____

and any legal equivalent thereof in a foreign country, including the right to claim priority and, in and to, all Letters Patent to be obtained for said invention by the above application or any continuation, division, continuation-in-part, extension or substitute thereof, and any reissue, reexamination or extension of said Letters Patent and all rights under all International Conventions for the Protection of Industrial Property;

ASSIGNOR(S) hereby covenants that no assignment, sale, agreement or encumbrance has been or will be made or entered into which would conflict with this assignment;

ASSIGNOR(S) further covenants that ASSIGNEE will, upon its request, be provided promptly with all pertinent facts and documents relating to said invention and said Letters Patent and legal equivalents as may be known and accessible to ASSIGNOR and will testify as to the same in any interference, litigation, or proceeding relating thereto and will promptly execute and deliver to ASSIGNEE or its legal representative any and all papers, instruments or affidavits required to apply for, obtain, maintain, issue or enforce said application, said invention and said Letters Patent and said equivalents thereof which may be necessary or desirable to carry out the purposes thereof. An attorney of record is authorized and requested by the execution of this assignment to insert into this assignment the filing date and serial number of said application when officially known.

AND the ASSIGNOR(S) requests the Assistant Commissioner for Patents to issue said Letters Patent of the United States and any reissue or extension thereof to the ASSIGNEE, The Regents of the University of California.

executed this

23 day of Aug, 2001

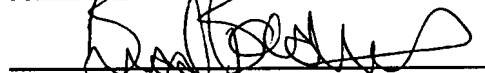
23 day of Aug, 2001

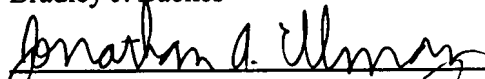
27 day of Aug, 2001

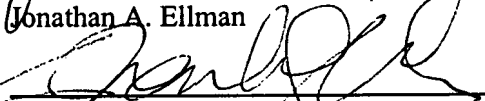
27 day of August, 2001

Signature of Inventor(s)


Jennifer L. Harris


Bradley J. Backes


Jonathan A. Ellman


Charles S. Craik



VERIFIED STATEMENT (DECLARATION) CLAIMING SMALL ENTITY STATUS
(37 CFR 1.9(f) & 1.27(d)) - NONPROFIT ORGANIZATION

Applicant/Patentee:
Application or Patent No.:
Filed or Issued:
Title:

Jennifer L. Harris, et al.

09/866,132

May 25, 2001

PROFILING OF PROTEASE SPECIFICITY USING COMBINATORIAL FLUOROGENIC SUBSTRATE LIBRARIES

I hereby declare that I am an official empowered to act on behalf of the nonprofit organization identified below:

Name of Nonprofit Organization:
Address of Nonprofit Organization:

University of California, San Francisco
Office of Technology Management
P.O. Box 1209, 1294 9th Avenue, Suite 1
San Francisco, CA 94143-1209

The Regents of
The University of California
1111 Franklin Street, 12th Floor
Oakland, CA 94607

Type of Nonprofit Organization:

- ☒ University or other institution of higher education.
☐ Tax exempt under Internal Revenue Service Code [26 USC 501(a) and 501(c)(3)].
☐ Nonprofit scientific or educational under statute of state or the United States of America
(Name of State _____).
☐ Would qualify as tax exempt under Internal Revenue Service Code [26 USC 501(a) and 501(c)(3)] if located in the United States of America.
☐ Would qualify as nonprofit scientific or educational under statute of state of the United States of America if located in the United States of America
(Name of State _____)
(Citation of statute _____).

I hereby declare that the nonprofit organization identified above qualifies as a nonprofit organization as defined in 37 CFR 1.9(e) for purposes of paying reduced fees to the United States Patent and Trademark Office regarding the invention, entitled PROFILING OF PROTEASE SPECIFICITY USING COMBINATORIAL FLUOROGENIC SUBSTRATE LIBRARIES by inventor(s) described in:

- ☐ the specification filed herewith;
☒ Application No. 09/866,132, filed May 25, 2001;
☐ Patent No. _____, issued _____.

I hereby declare that rights under contract or law have been conveyed to and remain with the nonprofit organization regarding the above identified invention.

If the rights held by the nonprofit organization are not exclusive, each individual, concern or organization having rights in the invention is listed below* and no rights to the invention are held by any person, other than the inventor, who would not qualify as an independent inventor under 37 CFR 1.9(c) if that person made the invention, or by any concern that would not qualify as a small business concern under 37 CFR 1.9(d), or a nonprofit organization under 37 CFR 1.9(e).

*NOTE: Separate verified statements are required from each named person, concern or organization having rights to the invention averring to their status as small entities. (37 CFR 1.27)

Name: _____
Address: _____

☐ Individual ☐ Small Business Concern ☐ Nonprofit Organization

Name: _____
Address: _____

☐ Individual ☐ Small Business Concern ☐ Nonprofit Organization

I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate. (37 CFR 1.28(b))

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

Name of Person Signing: Susan Y. Nakashima
Title in Organization of Person Signing: Business Manager
Address of Person Signing: Office of Technology Management
P.O. Box 1209, 1294 9th Avenue, Suite 1
San Francisco, CA 94143-1209

Signature: Susan Y. Nakashima

Date: August 13, 2001